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IN THE

Supreme Court of the United States

OCTOBER TERM, A.D. 1975

No. 75-8241

LOUIS I. FELDMAN,

Petitioner,

vs.

KNUD AUNSTRUP,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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No.

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vs.

KNUD AUNSTRUP,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Louis I. Feldman prays that a Writ of Certiorari issue to review the decision of the United States Court of Customs and Patent Appeals in the case entitled *Louis I. Feldman v. Knud Aunstrup*, P.A. No. 74-602.

OPINIONS OF THE TRIBUNALS BELOW

This case arises from a United States Patent and Trademark Office Interference proceeding No. 97,703. The Patent Office Board of Patent Interferences awarded priority of invention to Knud Aunstrup in a decision dated November 16, 1973, and on reconsideration dated February 12, 1974, which decisions are appended hereto as Appendix A. These decisions are unreported.

Upon appeal the United States Court of Customs and Patent Appeals affirmed the award of priority of invention to Knud Aunstrup, in a decision dated June 19, 1975, reported at 517 F.2d 1351 and 186 USPQ108. A copy of the Court decision as reported in 517 F.2d 1351 is hereto appended as Appendix B. The Court denied a Feldman petition for rehearing September 18, 1975.

JURISDICTION

Jurisdiction of this Court is invoked under Title 28, U.S. Code, Section 1256.

This petition is filed within the ninety days' period permitted under Title 28, U.S. Code, Section 2101(c), from the Court of Customs and Patent Appeals rehearing denial of September 18, 1975.

QUESTIONS PRESENTED

The following questions are presented by this petition:

1. In a case where access to a micro organism is necessary for adequacy of disclosure in an application for United States Letters Patent, is a deposit of such organism, under secrecy, in a private depository, in a foreign country, a compliance with the disclosure requirements of Title 35 U.S. Code, Section 112?

2. If a United States patent application is given a filing date, based upon such a deposit upon the premise that the disclosure may be augmented thereafter, is this not contra to the rationale of Title 35 U.S. Code, Section 102(e), and the decisions by this Court in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926); and *Hazeltine Research Inc. v. Brenner*, 382 U.S. 252 (1965)?

3. Does Title 35 U.S. Code, Section 114 (or the enabling Patent Office Rule 37 CFR 1.93) constitute authority for the proposition that a patent application disclosure, insufficient as filed, may be rendered complete retroactively, upon the applicant's compliance with an order of the Patent and Trade Mark Office?

4. If a United States patent application is given a filing date, based upon a deposit in a foreign country, is this not contra to the specific language and provisions of Title 35 U.S. Code, Section 104, whether the deposit be "secret" or "open," and whether the depository be public or private?

5. Does Title 35 U.S. Code, Section 119 modify 35 USC 104, to provide authority for granting unto a United States patent application, a filing date based upon a micro organism deposit in a foreign country?

STATUTES AND RULES INVOLVED IN THE QUESTIONS PRESENTED

Title 35 U.S. Code, Section 112, first paragraph, provides as follows:

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Title 35 U.S. Code, Section 102(e) reads as follows:

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

Title 35 U.S. Code, Section 114, and the enabling Patent Office Rule (37 CFR 1.93) read as follows:

§ 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

§ 1.93 Specimens

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

Title 35 U.S. Code, Section 104, in its pertinent parts reads as follows:

§ 104. Invention made abroad

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title.

Title 35 U.S. Code, Section 119, in its pertinent provisions reads as follows:

§ 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application

in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

The decision by the Court of Customs and Patent Appeals makes reference to the Patent Office Commissioner's Notice of April 29, 1971, 886 O.G. 638 (now M.P.E.P. 608.01)) which reads as follows:

Deposit of Microorganisms
Notice April 29, 1971

Some inventions which are the subject of patent applications depend on the use of microorganisms which must be described in the specification in accordance with 35 U.S.C. 112. No problem exists when the microorganisms used are known and readily available to the public. When the invention depends on the use of a microorganism which is not so known and readily available, applicants must take additional steps to comply with the requirements of Section 112.

In re Argoudelis et al., 168 USPQ 99 (CCPA, 1970), accepted a procedure for meeting the requirements of 35 U.S.C. 112. Accordingly, the Patent Office will accept the following as complying with the requirements of Section 112 for an adequate disclosure of the microorganism required to carry out the invention:

(1) The applicant, no later than the effective U.S. filing date of the application, has made a deposit of a culture of the microorganism in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted, under conditions which assure (a) that access to the culture will be available during pendency of the patent application to one determined by the Commissioner to be entitled thereto under Rule 14 of the Rules of Practice in Patent Cases and 35

U.S.C. 122, and (b) that all restrictions on the availability to the public of the culture so deposited will be irrevocably removed upon the granting of the patent;

(2) Such deposit is referred to in the body of the specification as filed and is identified by deposit number, name and address of the depository, and the taxonomic description of the extent available is included in the specification; and

(3) The applicant or his assigns has provided assurance of permanent availability of the culture to the public through a depository meeting the requirements of (1). Such assurance may be in the form of an averment under oath or by declaration by the applicant to this effect.

A copy of the applicant's contract with the depository may be required by the Examiner to be made of record as evidence of making the culture available under the conditions stated above.

RICHARD A. WAHL

Assistant Commissioner.

April 29, 1971.

Title 35 U.S. Code, Section 122 and Patent Office Rule 14 (37 CFR 1.14—first paragraph) referred to in the foregoing notice read as follows:

§ 122. Confidential status of applications

Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

§ 1.14 Patent applications preserved in secrecy

(a) Except as provided in § 1.11(b) pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his assignee or attorney or agent of record, unless it shall be necessary to the proper conduct of business before the Office or as provided by this part.

STATEMENT OF THE CASE AND THE FACTS

The Issue

Where access to a micro organism is necessary for adequacy of disclosure in a United States patent application,[1] is it legally sufficient to deposit the organism, under a secrecy agreement, in a private depository, in a foreign country? Stated more specifically, the question involved is whether such a deposit can constitute a compliance with the disclosure requirements of 35 USC 112, upon the premise that the disclosure may be augmented at a later date. Also involved, is the very pertinent question of whether a deposit in a foreign country can constitute a compliance with United States law, 35 USC 104, regardless of the nature of the depository, and regardless of the nature of the terms of deposit.

The Facts

In September, 1965, Knud Aunstrup, a Danish national, isolated the micro organism here concerned from a compost pile in his garden in Copenhagen.[2] After certain correspondence between Novo Industri A/S, Aunstrup's assignee, and Centralbureau voor Schimmelculturen (CBS), a depository in Baarn, Holland, a sample of the culture was caused to be deposited with CBS, and given the designation CBS 370.65. The deposit was made as a "secret" deposit, viz., not accessible to the public, or to anyone, without the

[1] No question has been raised but that access to the micro organism is necessary for sufficiency of disclosure in the patent application here involved.

[2] The organism or culture produces a milk coagulating enzyme useful in the production of cheese.

permission of Novo. The deposit was made November 18, 1965.

The terms of the deposit are set forth in the document attached hereto as Appendix C. Although this particular document was not in existence in November, 1965, a witness Dr. DeVries, a representative of CBS, testified that this document accurately sets forth the terms attaching to a CBS "secret" deposit at the time. As will be seen by reference to the document, Appendix C, a "secret" deposit will be available to third parties only on formal authorization from the depositor (Novo). Further, the deposit is geared to a Netherlands patent application, viz., the deposit will be available to anyone upon request, if and when the Netherlands Patent Office informs CBS that a corresponding Netherlands patent application has been accepted; but if notified that the application will not be published, then CBS will destroy the culture.[3]

At the time of the deposit, in November, 1965, CBS was a private organization. It became an arm of the Dutch Government, at a later date, sometime in 1968.

On December 2, 1965, Aunstrup (Novo) filed in Great Britain a British provisional patent specification, Serial No. 51,270. Aunstrup also caused to be filed in Belgium an application which became Belgium patent No. 690,571 and which issued sometime prior to November 14, 1968.[4]

---

[3] Thus, the culture would be destroyed regardless of a pending United States patent application.

[4] In the brief for Aunstrup before the Court of Customs and Patent Appeals, it is mentioned that a Netherlands patent application was also filed. However, no reference to such an application appears in the record; the Court of Customs and Patent Appeals ignored it; and both parties agree that whether or not it was filed is immaterial to the issue, and accordingly it will herein be disregarded.

On November 22, 1966, approximately one year after the British provisional, Aunstrup filed a complete specification in Great Britain, which became British patent No. 1,108,287; and at approximately the same date, viz., on November 21, 1966, Aunstrup filed his United States patent application Serial No. 595,643, here involved.

On December 6, 1967, your petitioner Feldman filed his application for United States Letters Patent, Serial No. 688,349, here involved.

On or about November 14, 1968, Dr. E. J. Beckhorn, an associate of your petitioner Feldman, became aware of the Aunstrup deposit at CBS by reason of the issuance of the above Belgium patent. Beckhorn wrote to CBS for access to the deposit, and CBS in turn wrote to Novo for access permission. Novo refused access and CBS in turn communicated this to Dr. Beckhorn.

Then at a later date, on March 20, 1969, for whatever reason, Novo changed its mind and decided to make the culture an "unrestricted" deposit, and a few days later on March 25, 1969, CBS placed the culture CBS 370.65 in its collection of unrestricted deposits.

The Proceedings Below

On July 6, 1971 the interference of these proceedings, Interference No. 97,703 was declared between the aforesaid Aunstrup United States patent application Serial No. 595,643 filed November 21, 1966, and your petitioner's aforesaid Feldman application Serial No. 688,349 filed December 6, 1967.

The Board of Patent Interferences in its decision of November 16, 1973 (Appendix A) gave Aunstrup the benefit of the filing date of the Aunstrup British

provisional specification, December 2, 1965; and the Board also gave Aunstrup the benefit of his United States application as of its filing date.[5]

Appeal was taken by your petitioner Feldman to the Court of Customs and Patent Appeals upon the issue of whether Aunstrup is entitled to the filing date of his United States application, and this is the issue presented by the present petition to this Court. The Court of Customs and Patent Appeals in its decision of June 19, 1975 (Appendix B) held that Aunstrup is so entitled.

[5] The Board also held certain priority proofs of Feldman to be insufficient—a point not here involved.

REASONS FOR GRANTING THE WRIT

Your petitioner respectfully submits that the decision below by the Court of Customs and Patent Appeals directly violates the disclosure requirements of 35 USC 112, and finds no support in 35 USC 114; and the decision below also directly violates the provisions of 35 USC 104 in its prohibition of reliance upon acts in countries foreign to the United States.

It is submitted that the decision by the Court of Customs and Patent Appeals in its premise that a disclosure may be augmented after filing is also contrary to the clear rationale of 35 USC 102(e) and the decisions by this Court in *Alexander Milburn Co. v. Davis-Bournonville Co.* supra, and *Hazeltine Research, Inc. v. Brenner* supra.

As noted by the Court of Customs and Patent Appeals in its decision (Appendix B-6), there is proposed legislation on the subject of foreign micro organism deposits; and your petitioner further respectfully submits that the drafters of any such proposed legislation should have the benefit of the views and rulings by this Court upon this important subject, under the statutes presently standing in the United States Code. The propriety of deposits is basic to the public interest in a large segment of the pharmaceutical patent system.

ARGUMENT

In the landmark decision of *Alexander Milburn Co. v. Davis-Bournonville Co.*, supra, (1926) this Court held that a United States patent application, although secret until it issues as a patent, is effective as a reference *as of its filing date* by reason of its special character. In the Patent Act of 1952 the U.S. Code was amended in conformity with this ruling, Title 35, Section 102(e), to so provide. This Court followed the reasoning of its earlier decision in *Hazeltine Research, Inc. v. Brenner*, supra (1965).

If a United States patent application is to be effective as a reference against others *as of its filing date* as held by this Court, then it is axiomatic that its disclosure must be complete *as of its filing date*, not to be augmented during the prosecution of the application, in accordance with the whims and vagaries of the applicant.

In its decision below, the Court of Customs and Patent Appeals says (Appendix B-5):

> [3] It is true, as Feldman asserts, that *as of the 1966 filing date* of Aunstrup's U. S. application, there was no guarantee or assurance of access to CBS 370.65 by the public upon issuance of a U. S. patent on the application. However, the enablement requirement of § 112, first paragraph, does not require such assured access to a microorganism deposit *as of the filing date*; what is required is assurance of access (to the microorganism culture by the public upon issuance of a patent on the application) prior to *or during the pendency* of the application, so that, upon issuance of a U. S. patent on the application, "the public will, in fact, receive

> something in return for the patent grant." *In re Argoudelis*, 434 F.2d at 1394, 58 CCPA at 776 (Baldwin, J., concurring).

Your petitioner respectfully submits that this stated philosophy is directly contrary to the rulings by this Court in *Alexander Milburn Co. v. Davis Bournonville Co.*, supra, and *Hazeltine Research, Inc. v. Brenner*, supra, and directly contrary to 35 USC 102(e), all of which presuppose that a patent application must be complete *as of its filing date*, in accordance with the disclosure requirements of 35 USC 112.

The Court below asserts support for its position, from 35 USC 114 where it says (Appendix B-4):

> [1] In regard to part (1), we see no merit. Under the authority of 35 U.S.C. § 114,[4] the PTO may require an applicant to furnish specimens for the purpose of inspection or experiment. PTO Rule 93, 37 CFR 1.93,[5] implements this statutory authority. Hence, there is no question that the PTO *could* obtain access to CBS 370.65 *through Aunstrup* at any time during pendency.

Your petitioner respectfully submits that this is a clear misinterpretation of 35 USC 114. This statute has to do with the demonstration of utility or operativeness, and not with augmented disclosure. Thus an applicant who files an application on a perpetual motion machine, may be required to supply a model to prove that the structure is operative. But 35 USC 114 does not sanction or authorize the retroactive additions to an incomplete disclosure, to render it complete.

In its decision, the Court below makes reference to its prior decision in *In re Argoudelis, et al*, 58 CCPA 769; 434 F.2d 1390; 168 USPQ 99 (1970) but did not follow it. In *Argoudelis* the deposit was in the United States, with the Department of Agriculture, an agency of the United

States Government. The deposit was under "secrecy" but it was made pursuant to a contract which obligated the depository (the United States Government) to make the micro organism public upon issuance of the United States patent. In *Argoudelis* the Court laid down four factors which formed the basis for the *Argoudelis* decision, here repeated by the Court (Appendix B-5). At least three of the four listed factors are missing in the present case. If the decision now made by the Court below is permitted to stand, *Argoudelis* and the Patent Commissioner's Notice of April 29, 1971 are meaningless. The decision by the Court below, without overruling *Argoudelis*, is thus further error which should be corrected by this Court.

Your petitioner further respectfully submits that the decision by the lower Court *is directly contrary to the specific language of 35 USC 104.* The language of 35 USC 104 could not be more clear that an applicant for patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity in respect thereto, in a foreign country, except as provided in 35 USC 119. Deposit of a micro organism in Holland is certainly activity in a foreign country, and without access to the micro organism, the disclosure of the United States application is insufficient.

There is nothing in 35 USC 119 to support the lower Court's ruling. 35 USC 119 provides that under the circumstances set forth in the statute, an application filed in a foreign country "shall have the same effect as the same application would have if filed in this country." If the United States Aunstrup application Serial No. 595,643 is improper by reason of a defective disclosure, the same is true of the Aunstrup British provisional specification Serial No. 51,270, regardless of where or when filed.

CONCLUSION

Your petitioner respectfully submits that several key provisions of the Patent Act are in question in the present case requiring clarification and correction; in addition to the matter of pending legislation; and in addition to the confusion now created by failure of the lower Court to follow the reasoning of its own prior *Argoudelis et al* decision.

Wherefore, it is respectfully asked that this Court consider these matters, and grant the present petition.

Respectfully submitted,

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APPENDIX

APPENDIX

APPENDIX A

PATENT APPEAL NO. 74-602

[114] Opinion and Decision of Board of Patent Interferences, November 16, 1973

Gaston and Modance, Examiners of Interferences, Rollins, Acting Examiner of Interferences

Gaston, Examiner of Interferences

The subject matter of this interference is shown by the sole count:

> *Count 1* A process for the preparation of a milk-coagulating enzyme which comprises cultivating a milk-coagulating enzyme producing strain of *Mucor miehei* Cooney et Emerson or a natural or artificial variant or mutant thereof in a suitable nutrient medium, and thereafter recovering the milk-coagulating enzyme from the medium.

The party Aunstrup is senior in this interference. He further claims the benefit of his prior British application [115] filed December 2, 1965. His motion for the benefit of his British application was denied by the Primary Examiner.

Both parties took testimony, filed briefs and were represented by counsel at final hearing. Feldman took priority testimony. Aunstrup took testimony relevant to the issues of whether deposit of a microorganism in the Centraalbureau voor Schimmelculturen in the Netherlands meets the requirements of 35 USC 112 and rebuttal testimony with respect to the Feldman priority proofs.

The question of whether the Aunstrup application on the interference supports the count will first be discussed.

The Disclosure of the Aunstrup U. S. Application

As shown by the Aunstrup U. S. application in the interference, to carry out the process of the count of the interference *Mucor miehei* Cooney et Emerson CBS 370.65 is re-

quired. As stated in the application this Mucor strain was isolated in Copenhagen and identified at the Centraalbureau voor Schimmelculturen, Baarn, Holland (CBS) as falling within the group *Mucor miehei* Cooney et Emerson. This strain was deposited in this institution under the CBS number 370.65.

Feldman states, and Aunstrup appears to agree, that the Aunstrup disclosure, for adequacy, requires access to culture CBS 370.65. The question presented here is whether the conditions as to the CBS deposit satisfy the requirements of 35 USC 112.

Feldman urges that CBS is not a proper depository for disclosure of an application for a United States patent because CBS is not a United States government agency, it is not within [116] the territory of the United States and it is not subject to United States law. We find no basis for this statement. While these factors were true of the depository in the case of In re Argoudelis et al. 58 CCPA 769, 434 F.2d 1390, 168 USPQ 99, which depository was a United States government agency in the territory of the United States, the Court did not hold that these are requirements for proper deposit for a United States patent application. This is shown by the fact that the notice of Assistant Commissioner Wahl of April 29, 1971, 886 O.G. 638 makes no such restrictions on the depository, saying only that deposit should be made "in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted." As Aunstrup states, there is no rule of law that the depository be a United States government agency and that the depository be located within the territory of the United States. In our view CBS is a depository, being operated by the Dutch government. Nor is it apparent how there would be any difficulty as to the enforceability of contractual commitments with CBS.

There should be permanent accessibility of the deposit to the public if and when the patent issues and accessibility to the Commissioner of Patents and his designees during the pendency of the application.

Aunstrup isolated a culture from a heap of grass collected in his garden in connection with his study of enzyme-producing fungi in 1965 and sent it to CBS which he asked to identify, to accept it as the species *Mucor miehei* and to have it incorporated in their collection of restricted cultures (A 11, 12, 105; A Exh. I-5). On November 5, 1965 CBS responded that the culture sent them by Aunstrup was Mucor miehei Cooney et Emerson and would [117] be taken care of as a restricted culture (A Exh. I-6; A 105) and was deposited under the number CBS 370.65 (A Exh. 1-7).

Aunstrup Exhibit I-2 is a form of receipt given to depositors of restricted cultures by CBS showing the conditions maintained by the depository as to access to the culture (A 94, 95), that the depositor is their client, that the culture must be restricted and that only the depositor can give written consent to send it to other people. When the strain is mentioned in a patent application in the Netherlands, the strain is available to anyone upon request when the Netherlands patent application is accepted, that is, becomes a patent.

However, on March 20, 1969 Aunstrup wrote a letter to CBS, A Exhibit I-9, in which he authorized CBS from that date to distribute the culture 370.65, representing the *Mucor miehei* strain which he had deposited, to any person who might be interested in a sample of this one for investigative purposes (A 107, 108; A Exh. I-9).

The Aunstrup application in interference has not yet issued as a patent. However, if the Aunstrup application should now issue as a patent, in view of the Aunstrup letter, Aunstrup Exhibit I-9, the general public would have access to the culture.

As to the requirement of the Argoudelis et al. decision as to supplying samples to persons legally entitled under Rule 14 and 35 USC 122, it was pointed out above that strains will be given to third parties on a formal authorization of the

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depositor. Thus, on request of the Commissioner to the depositor-applicant and notification of CBS by the latter, samples of the culture would [118] have been furnished to those legally entitled under Rule 14 and 35 USC 122. We thus consider the requirements of In re Argoudelis et al. to have been complied with. As Aunstrup states, any means which are effective to accomplish the required result must be considered acceptable.

On page 31 of his main brief and on page 7 of his reply brief, Feldman takes the position that certain of the Aunstrup exhibits were not served upon Feldman prior to the taking of the Aunstrup testimony and in certain instances Aunstrup was in possession. It is not clear whether this is an objection by the party Feldman.

On page 73 of the Aunstrup record counsel for Aunstrup moved into evidence Aunstrup Exhibits I-1 through I-13.

Counsel for Feldman thereupon stated that "a number of these were not served upon us prior to to-day's deposition ...." The only specific exhibit mentioned was I-9.

Counsel for Aunstrup then set forth the basis on which these documents were offered. Thereupon counsel for Feldman made no objection to moving the Aunstrup exhibits into evidence.

The Aunstrup testimony was taken on July 6 and 7, 1972 pursuant to the granting of a motion by the Board of Patent Interference to permit Aunstrup to take testimony in chief to call Aunstrup, Hesseltine, Emerson and De Vries as witnesses to give testimony relevant to the issue of whether it was sufficient, to meet the requirements of 35 USC 112 (1) to deposit a microorganism in C.B.S. and (2) to deposit a single example of the microorganism species in question. Times were set:

> [119] Time for service under Rule 287(a) by Aunstrup of documents and lists to close July 7, 1972.
>
> Testimony of Aunstrup to close August 7, 1972.

The testimony of De Vries, during which the Aunstrup Exhibits I-1 to I-13 were introduced, was taken on July 6, 1972, as shown by the record (A 151). Thus these exhibits were served on the party Feldman before the close of the time set for service under Rule 287(a) by Aunstrup, July 7, 1972.

Further, Aunstrup urges that to the extent that copies of these documents were in the possession, custody or control of Aunstrup or his counsel, they were duly and properly served upon the party Feldman under Rule 287(a) and that to the extent that the documents introduced were not served, they were not in the possession, custody or control of Aunstrup for the reason that they remained in the possession, custody and control of the Dutch government, as represented by the witness De Vries. That is, the originals of these particular documents, which are exhibits relied on by Aunstrup, belonged to CBS and were brought over by De Vries to the United States for the taking of the testimony.

For these reasons, in these circumstances, we believe that the Aunstrup exhibits were properly served.

Accordingly, for the above reasons, we hold that the Aunstrup United States application in the interference supports the count.

The Aunstrup British Application

The party Aunstrup asserts that there is no difference between his British Provisional application and the Aunstrup U. S. application involved in the interference, as to the sufficiency of disclosure with regard to the Aunstrup deposit with CBS, with which the party Feldman agrees.

[120] We consider that the same reasons set forth above as to the adequacy of the CBS deposit with respect to the Aunstrup United States application also apply to the Aunstrup British application. Accordingly we hold that Aunstrup is entitled to the benefit of his British application filed December 2, 1965.

The December 2, 1965 effective filing date of Aunstrup is prior to any date asserted by Feldman for conception and re-

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duction to practice. Assuming, arguendo, that Aunstrup is not entitled to rely upon his British application, we will consider the Feldman priority proofs.

The Case for Feldman

The Question of Abandonment of the Invention

The claims in Feldman's prior application S.N. 631,608 filed April 18, 1967, the benefit of whose filing date Feldman received on declaration of the interference, employed the expression "a culture of *Mucor miehei*" in describing the organism used in the claimed process of preparing a microbial rennin.

In the original claims of Aunstrup application S.N. 688,349 filed December 6, 1967 in the interference the culture was expressed as "a selected strain of *Mucor miehei* (NRRL No.'s: 3169, A 7772, A 13131, A 13042 and 2543)." In present claim 1, corresponding to the count of the interference the culture is a strain of *Mucor miehei* selected from the group consisting of NRRL No.'s: 3169, A 7772, A 13131 and A 13042.

Aunstrup urges (brief, page 42) that, by the acts of Feldman set forth above, the invention defined by the count in issue has been abandoned under 35 USC 102(g), that the effect [121] of this abandonment is to eliminate and preclude the standing of the party Feldman in the present proceedings, to bar a grant of priority to the party Feldman and, when ex parte prosecution resumes, to bar the issuance to the party Feldman of the count of interference with 35 USC 102(c).

We do not agree. This interference was declared in accordance with Rule 203, the practice being as set forth in Tolle et al. v. Starkey, 45 CCPA 979, 255 F.2d 935, 118 USPQ, the Court there stating:

> . . ., Starkey's later application, which is involved in the interference, does not contain a claim exactly corresponding to the count but a similar claim which re-

cites only rubber as a material to be coated and 250°F. as the temperature to which it is to be heated.

See Rule 203 and the last paragraph of Section 1101.01 (j) of the Manual of Patent Examining Procedure, Rev. 32, Apr. 1972, which also refers to Section 1101.02 C II (b). The count does not appear as a claim in the Aunstrup application. Claim 1 of Feldman corresponds to the count. Should Feldman be successful in the interference, he would be entitled to priority as to his claim 1 which corresponds to the count.

No basis is found for the Aunstrup charge that Feldman abandoned the invention of the count by narrowing his claims in his second filed application.

As strains of *Mucor michei* for use in the process, Feldman has disclosed substantially the same strains in both applications, NRRL 2543, A 6588, A 7772, A 13042 and A 13,131 in the parent application and NRRL 2543, NRRL 2543, A 7772, A 13042 and A 13,131 [122] in the application in interference. This latter application shows that A 6588 was not effective in the process. Thus the differences in the disclosures present no ground for a holding of abandonment of the invention of the count by Feldman.

Aunstrup concedes, brief, page 41, that the individual strains disclosed and claimed in the Feldman application in interference are sufficient to support the count, so that no question of support for the count is being raised. Miller v. Hayman, 18 CCPA 848, 46 F.(2d) 188, 1931 CD 137, 8 USPQ 188 has to do with suppression and concealment under 35 USC 102(g), along with spurring, as was present in Mason v. Hepburn, 13 App. D.C., 84 O.G. 147, 1898 CD 510 and has no relation to the present situation. Schmidinger v. Welsh, 383 F.2d 455, 155 USPQ 289, an infringement case, also has no relation to the Aunstrup charge of abandonment of the invention of the count by Feldman in the present case.

Accordingly, we hold that Feldman has not abandoned the invention of the count.

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PATENT APPEAL NO. 74-602

Alleged Failure of Feldman to Comply With Rule 287

Aunstrup on April 7, 1972 filed a request for service upon him by the party Feldman, as provided by Rule 287(a). On May 10, 1972 service of documents on the party Feldman was made. Under Appendix A the following documents were served:

Letter, March 16, 1966, L. I. Feldman
Letter, July 25, 1966, L. I. Feldman
Letter, August 2, 1966, C. W. Hesseltine
[123] Letter, September 22, 1966, L. I. Feldman
Letter, September 28, 1966, C. W. Hesseltine
Laboratory Sheet 120, August 24, 1966, E. Molokie
Laboratory Sheet 127, October 26, 1966, E. Molokie
Laboratory Sheet 127(a), October 27, 1966, E. Molokie
Laboratory N.B. 309, page 2, October 27, 1966, L. I. Feldman
Laboratory N.B. 309, page 15, November 10, 1966 L. I. Feldman

Invention Record Form, October 28, 1966, L. I. Feldman
Letter, November 3, 1966, E. J. Beckhorn

Under Appendix B, Feldman set forth a list of and a proffer of reasonable access to things in his possession custody or control upon which he intended to rely:

Cultures of Mucor miehei strains NRRL 2543, 3169, A 7772, A 13,042, A 13,131

Edward Molokie Lab. Notes, Experiments 113-178

L. I. Feldman Lab. Notebook No. 309

In the taking of the testimony by the party Feldman numerous additional documents not listed in Appendix A and not served on the party Aunstrup under Rule 287 were introduced and moved into evidence by the party Feldman by motion dated June 23, 1972 (F 335; Paper No. 49). The motion is opposed by Aunstrup (Paper No. 50).

It is thus apparent, as stated by Aunstrup, that the party Aunstrup had no notice prior to the actual taking of the testimony, by service under Rule 287(a), by motion under Rule 287(d) (1). [124] nor by informal exchange of information between counsel of the additional documents. Aunstrup states that the original documents were made available for inspection at the taking of the Feldman testimony but no copies were provided of most of these documents. It appears that the documents were informally transmitted to Aunstrup by counsel for Feldman on October 13, 1972, four months after the taking of the Feldman testimony.

The June 21, 1972 motion by Feldman under Rule 287(d) (1) failed to include with the serving of the motion the documents in question, as required by the rule. The motion was brought after the time for the party Aunstrup to cross-examine, and to prepare for such cross-examination had ended.

It thus appears that at the taking of the Feldman testimony Aunstrup was taken by surprise by the introduction of many documents which had never been served on him in accordance with Rule 287(a). The documents listed in Appendix A, set forth above, had been properly served. Thus Aunstrup was justified in believing that these documents, which came from the Molokie Lab. Notes and L. I. Feldman Lab. Notebook No. 309, were the only documents upon which Feldman intended to rely and that the party Aunstrup needed to consider.

The proffer of access, under Appendix B, then, appeared to be merely making available for inspection the originals of the documents of Appendix A which were contained in the laboratory notebooks of Molokie and of Feldman. While Feldman listed these notebooks as "things," in taking his testimony he proceeded to introduce as exhibits individual pages of the notebooks as "documents," as they should have been listed and served under Appendix A.

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[125] While Aunstrup urges (brief, page 36) that the entire record of Feldman should be stricken because of the failure of Feldman to comply with Rule 287, we do not believe that that is justified under the circumstances of this case.

The motion of Feldman filed June 23, 1972, Paper No. 49, that consideration be given at final hearing to all of the documents and the testimony of all of the witnesses offered in evidence and presented in depositions for the party Feldman taken on June 15th and 16th, 1972 is granted only with respect to the documents listed under Appendix A in the Feldman Service of Documents and Lists under Rule 287 (a) filed May 10, 1972, Paper No. 45 and is denied with respect to the following documents, as listed by Aunstrup:

Exhibit G, pages 1-12 and 14-16 of Feldman Laboratory Notebook 309, excepting pages 2 and 15;

Exhibit H, pages 120-128 of Edward Molokie laboratory notes, excepting pages 120, 127 and 127 (a);

Exhibit J, rennin activity assays;

Exhibit K, rennin activity assays;

Exhibit L, "Microbial Rennin" notebook;

Exhibit M, proteolysis data;

Exhibit N, proteolysis data.

Likewise, testimony concerning these exhibits will not be considered, for the reasons set forth above:

Page 56 (Gagan-direct) Q18 to page 57, (Gagan-direct) Q25;

Page 58 (Gagan-cross) XQ1 to page 59 (Gagan-cross) XQ9;

Page 60 (Gagan-cross_ XQ15 to page 61 (Gagan-cross) XQ17;

[126] Page 82 (Feldman-direct) Q22 to page 82 (Feldman-direct) Q23;

Page 84 (Feldman-direct) Q30 to page 84 (Feldman-direct) Q31

Page 99 (Feldman-direct) Q81 to page 100 (Feldman-direct) Q83;

Page 102 (Feldman-direct) Q94 to page 104 (Feldman-direct) Q104;

Page 106 (Feldman-direct) Q113;

Page 117 (Feldman-direct) Q149 to page 122 (Feldman-direct) Q156;

Page 123 (Feldman-direct) Q160, answer, second paragraph;

Page 129 (Feldman-direct) Q177 to page 137 (Feldman-direct) Q198;

Page 138 (Feldman-direct) Q200 to page 140 (Feldman-direct) Q210;

Page 141 (Feldman-direct) Q212 to page 151 (Feldman-direct) Q252;

Page 152 (Feldman-direct) Q254 to page 156 (Feldman-direct) Q261;

Page 157 (Feldman-direct) Q263 to page 163 (Feldman-direct) Q290;

Page 165 (Feldman-direct) Q291 to page 170 (Feldman-direct) Q303;

Page 171 (Feldman-direct) Q309 to page 179 (Feldman-direct) Q334;

Page 184 (Feldman-direct) Q353 to page 184 (Feldman-direct) Q355;

Page 185 (Feldman-cross) XQ2 to page 186 (Feldman-cross) XQ3;

Page 259 (Aiello-direct) Q11 to page 275 (Aiello-RDQ) RDQ4;

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Page 283 (Molokie-direct) Q38 to page 287 (Molokie-direct) Q61;

Page 289 (Molokie-direct) Q68 to page 311 (Molokie-direct) Q151;

[127] Page 311 (Molokie-direct) Q153 to page 312 (Molokie-direct) Q155;

Page 313 (Molokie-direct) Q157 to page 323 (Molokie-direct) Q190; and

Page 324 (Molokie-direct) Q195 to page 325 (Molokie-direct) Q196.

On page 3 and 4 of the Feldman Motion Re Documents and Witness under Rule 287, Feldman refers to these exhibits as being cumulative and states, main brief, page 30, that the Feldman testimony considered only with those documents concerning which there is no controversy is sufficient to support the Feldman priority position.

The Feldman Priority Proofs

The Feldman priority evidence confined to the documents listed under Appendix A of the Feldman Service of Documents and Lists Under Rule 287 (a) will be considered. These are:

Letter, March 16, 1966, L. I. Feldman F Exh. B

Letter to Hesseltine, July 25, 1966, L. I. Feldman F Exh. C

Letter to Feldman, August 2, 1966, C. W. Hesseltine F Exh. D

Letter to Hesseltine, September 22, 1966, L. I. Feldman, F Exh. E

Letter to Feldman, September 28, 1966, L. I. Feldman, F Exh. F

Laboratory Sheet 120, August 24, 1966, E. Molokie, F Exh. H-120

Laboratory Sheet 127, October 26, 1966, E. Molokie, F Exh. H-127

Laboratory Sheet 127 (a), October 27, 1966, F Exh. H-127 (a)

[128] Laboratory N. B. 309, page 2, October 17, 1966, L. I. Feldman, F Exh. G-2

Laboratory N. B. 309, page 15, November 10, 1966, L. I. Feldman, F Exh. G-15

Invention Record Form, October 28, 1966, L. I. Feldman, F Exhs. A-1 to A-5

Letter to Pollock, November 3, 1966, E. J. Beckhorn, F Exh. A-1

Beckhorn, director of research at Wallerstein Company Laboratories, testified that he accompanied Feldman and Gagan, also Wallerstein employees, to see Hesseltine, the director of the culture collection at the Northern Utilization Research and Development Division, U. S. Department of Agriculture, Agricultural Research Service at Peoria, Illinois. There they told Hesseltine that they were interested in a wide variety of organisms as potential enzyme sources and that they were looking among other things for a source of rennet from a microorganism. They asked Hesseltine for any cultures that he might have heard of or that might have come into the collection that could be of use to them for any number of purposes that they were interested in. This appears to have been in the summer of 1966. Hesseltine mentioned some organisms in the collection which they classified as *Mucor miehei* which were completely unexplored to the best of his knowledge with respect to the types and characteristics of enzymes produced by them.

Beckhorn further testified that Feldman made the association that these might be candidate enzymes for a microbial rennet (F 11, 12; F Exh. B).

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[129] After discussion, Feldman sought and obtained authorization from Beckhorn to acquire the culture and initiate exploratory research to see if this could be a good source of microbial rennet (A 13).

As shown by Feldman Exhibits C, D, E and F, Feldman had received *mucor miehei* cultures (NRRL [Northern Regional Research Laboratory] 3169 and 2543) and *Mucor* species considered by Hesseltine to be *Mucor miehei* (A 6588, A 7772, A 13042 and A 13131) by the end of September 1966.

The first work done with the cultures which Feldman received from the Northern Utilization and Development Division was fermentation of the cultures in different mediums, shown in the Molokie laboratory notebook pages, Feldman Exhibits H-120, dated 8/24/66, and H-127 and H-127 (a), dated 10/26/66, in different mediums, with different nutrients, in various proportions, and at various temperatures and time periods. The cultures listed above were employed (F 100-102, 104-120, 122-123, 280-283, 287-289). Since Molokie, who testified, worked along with Feldman in this fermentation work described above, we accept this work as having been corroborated. Since the witnesses Feldman and Molokie did this work together, we do not consider their testimony to be hearsay.

Feldman states in his main brief, pages 24 and 25, that assay data for the fermentations listed in Feldman Exhibits H-120 and H-127 is set forth in Feldman Exhibits J and K, respectively. Since we have held above that Feldman Exhibits J and K are excluded from the record because they were not properly listed and served under Rule 287, they cannot be considered.

[130] Feldman testified that Feldman Exhibit G-2 is essentially a recapitulation of L-19 and L-20 (F Exhs. L-19 and L-20) (F 154) and Feldman Exhibit G-15 is a recapitulation of part of L-127 and L-127 (a) (F 155). We note that L-127 and L-127 (a) under our ruling above are not included in the Feld-

man record. According to the testimony of Feldman, Exhibit L is also a recapitulation of Feldman Exhibit H-120 (F 142) and of Feldman Exhibits J and K, said to be assay sheets. Thus is appears that Feldman Exhibits G-2 and G-15 are not original records but recapitulations of recapitulations taken from records not in evidence in this interference. Exhibits G-2, dated 10/17/66 and G-15, dated 11/10/66 will be accepted for what they show since those who performed the work reported there, Feldman and Molokie, testified about them.

There is no testimony about the details of Feldman Exhibits G-2 and G-15. It appears that they show assay results from the microorganisms listed. The testimony about these exhibits does not explain the results and show how the results were obtained. While Feldman Exhibit I shows a method of rennin assay, there is no testimony in this record as presently constituted showing that this method was used and who used it. Accordingly, Feldman Exhibits G-2 and G-15 do not show reduction to practice of the invention of the count.

Feldman, Exhibit A-5 is also Feldman Exhibit G-11. Since Exhibit A-5, part of the Invention Report, was admitted as part of the Feldman record, Exhibit G-11 is also. Aunstrup withdrew his objection to that exhibit since Feldman Exhibit A-5 had been properly served (F 156, 157).

[131] Molokie testified (F 311) that Feldman Exhibit G-11 was part of a compilation of all the experiments that they had one in their laboratory on rennet. Aunstrup has objected to this exhibit on that ground as being a part of a compilation, as not being the best evidence and as being hearsay (Aunstrup brief, pages 45, 46). Feldman testified (F 154) that Feldman Exhibit G-11 is original data recorded here for the first time and that it shows an experiment conducted to determine the degree of proteolysis produced by NF (National Formulary) rennet and two new preparations containing rennet activity, specifically "309-10-9 to P_0 to 62" (F 156). Molokie also testified as to this proteolysis work of Feldman Exhibit G-11 (F 315-317). However, the Kjeldahl nitrogen determinations

which form a part of the table in Feldman Exhibit G-11 were stated to have been done in the analytical laboratory and they are not part of the record here. Also the material 309-10-9 P^0 to 62 is not otherwise identified. Feldman Exhibit A-4 is asserted to show the data of Feldman Exhibit A-5. However, it is unacknowledged and undated and relates to the material 309-10-P_0-62, not to the 309-10-9 P_0-62 of Feldman Exhibit A-5. Furthermore, it has not been shown how this determination of proteolytic activity of an asserted microbial rennet demonstrates reduction to practice of the invention of the count. For all of these reasons Feldman Exhibit G-11 or A-5 fails to show reduction to practice of the invention of the count.

Accordingly, whether on the basis of being given the benefit of his British application or on the basis of the filing date of his United States application in the interference, Aunstrup must prevail [132] in this interference.

Priority of invention is awarded to Knud Aunstrup, the senior party.

L. H. GASTON)
Examiner of Interferences)
)
WALTER A. MODANCE) BOARD OF PATENT INTERFERENCES
Examiner of Interferences)
)
ALTON D. ROLLINS,)
Acting Examiner of Interferences)

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[143] Opinion and Decision of Board of Patent Interferences, Feburary 12, 1974

RECONSIDERATION

Feldman petitions for reconsideration of our decision of November 16, 1973 awarding priority to Aunstrup. Aunstrup

has filed a reply thereto. Papers referred to in lines 3 to 6 of page 3 of the Aunstrup reply were not received. Furthermore papers which were not introduced into the interference in accordance with rules (Rules 251 et seq.) cannot be considered.

Feldman states that our decision made a mistake in fact on page 3 as to CBS (Centraalbureau voor Schimmelculturen) being operated by the Dutch government. We find no error in this statement as Feldman has in fact on page 2 of his petition quoted the testimony of De Vries (AR 89) that it became a governmental organization in 1968 which is prior to the declaration of this interference. That CBS is a Dutch government agency was stated on page 25 of the Aunstrup brief and this was not challenged by Feldman in his reply brief. As we pointed out on page 2 of our decision, the Notice of Assistant Commissioner Wahl of April 29, 1971, 886 O.G. 636 states only that deposit should be made "in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted".

[144] Our decision held that the Aunstrup deposit complied with the above Notice and In re Argoudelis et al., 58 CCPA 769, 434 F.2d 1390, 168 USPQ 99 without any dependence on whether CBS was or was not a Dutch government depository.

Feldman has made some comments in regard to the Aunstrup documents. Feldman made no objection to moving these documents into evidence at the taking of the Aunstrup testimony. He states that he did not move to exclude them at the time that the documents were offered and does not do so now. Accordingly, we find nothing here requiring reconsideration in our decision.

In Paper No. 38, filed April 7, 1972, entitled Request For Service Under Rule 287(a), the party Aunstrup requested service upon him by the party Feldman, as provided by Rule 287(a), of

1. A copy of each document in his possession, custody, or control and upon which he intends to rely.

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PATENT APPEAL NO. 74-602

In the taking of the testimony by the party Feldman documents not listed in Appendix A submitted by Feldman and not served on the party Aunstrup were introduced and moved into evidence. Aunstrup opposed. These documents, listed on page 12 of our decision, were never served on the party Aunstrup.

Since Rule 287 requiring service of documents relied on was not complied with by the party Feldman, we find no grounds for changing our decision as to excluding these exhibits from our consideration.

The party Feldman also urges that even though the exhibits not properly served were excluded, the oral testimony concerning them should not be excluded. We agree with the party Aunstrup that Rule 271 stated that evidence touching the matter at issue which shall not have been taken and filed in compliance with [145] these rules will not be considered in determining the interference. Also, see Josserand v. Taylor, 31 CCPA 709, 138 F.(2d) 58, 59 USPQ 140, 1943 C.D. 710, 716. Compare Quaker Oil Co., Inc. v. Quaker State Oil Refining Co., 22 CCPA 849, 856, 74 F.(2d) 553, 24 USPQ 115.

The petition for reconsideration has been granted to the extent that our decision has been reconsidered but is denied with respect to making any change or modifications therein.

L. H. GASTON)
L. H. Gaston)
Examiner of Interferences)
)
WALTER A. MODANCE)
Walter A. Modance)
Examiner of Interferences)
)
ALTON D. ROLLINS)
Alton D. Rollins, Acting)
Examiner of Interferences)

BOARD OF PATENT INTERFERENCES

APPENDIX B

Louis I. FELDMAN, Appellant,

v.

Knud AUNSTRUP, Appellee.

Patent Appeal No. 74–602.

United States Court of Customs and Patent Appeals.

June 19, 1975.

The Board of Patent Interferences awarded priority of invention, concerning process for preparation of milk-coagulating enzyme, involving a certain microorganism, and junior party appealed, challenging sufficiency of senior party's specification. The Court of Customs and Patent Appeals, Lane, J., held that senior party's deposit with foreign private depository, at first restricted but later made public, satisfied disclosure requirement.

Affirmed.

1. Patents ⇐100

In view of Patent Office authority to require applicant to furnish specimen, application for patent involving microorganism which, as of filing date, was deposited on condition that it be available to third parties only with inventor's permission, met requirements that there be assured availability of deposit to Patent Office. 35 U.S.C.A. § 114.

2. Patents ⇐97

Patent commissioner's notice stating that Patent Office would accept certain procedures as complying with statutory requirement of adequate disclosure of microorganism required to carry out invention did not set forth minimum requirements but only procedure which would assuredly gain Patent Office acceptance. 35 U.S.C.A. § 112.

3. Patents ⇐100

Enablement requirement, as applied to application for patent involving deposited microorganism, does not require assured public access to microorganism deposit as of filing date but only prior to or during pendency of application so that upon issuance public will have access. 35 U.S.C.A. § 112.

4. Patents ⇐99

Statutory function of establishing application filing date as prima facie date of invention was satisfied by specification describing invention fully capable of being reduced to practice. 35 U.S.C.A. § 112.

5. Patents ⇐100

Requirement that there be assured public access to essential starting material is violated only if disclosure is not complete at time of issue date. 35 U.S.C.A. § 112.

6. Patents ⇐100

Requirement of assured public access to microorganism essential to invention was satisfied where, during pendency of application, restrictions on access to deposited microorganism were removed and culture made open to public. 35 U.S.C.A. § 112.

7. Patents ⇐100

Applicant's deposit of microorganism essential to invention was adequate although depository was a private foreign depository, not agency of any government. 35 U.S.C.A. § 112.

Richard R. Trexler, Chicago, Ill. (Olson, Trexler, Wolters, Bushnell & Fosse, Ltd., Chicago, Ill.), attorney of record, for appellant.

Morris Fidelman, James S. Waldron, Washington, D.C. (Fidelman, Wolffe, Leitner & Hiney, Washington, D.C.), attorneys of record, for appellee.

Before MARKEY, *Chief Judge*, and RICH, BALDWIN, LANE and MILLER, *Judges*.

LANE, Judge.

This appeal by Feldman (junior party) is from the decision of the Patent and Trademark Office (PTO) Board of Patent Interferences awarding priority of invention to Aunstrup (senior party).

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The issues centers around Aunstrup's specification, which refers to a microorganism culture deposited in a foreign country, and the requirements of 35 U.S.C. § 112, first paragraph. Hence, this case is a sequel to *In re Argoudelis*, 434 F.2d 1390, 58 C.C.P.A. 769 (1970). The board held that Aunstrup's specification satisfies § 112, first paragraph, and we affirm.

The Subject Matter

The sole count reads:

> A process for the preparation of a milk-coagulating enzyme which comprises cultivating a milk-coagulating enzyme producing strain of *Mucor miehei* Cooney et Emerson or a natural or artificial variant or mutant thereof in a suitable nutrient medium, and thereafter recovering the milk-coagulating enzyme from the medium.

The count is identical to claim 9 of the involved Aunstrup application [1] and corresponds substantially to claim 1 of the involved Feldman application.[2]

The microorganism, *Mucor miehei*, is said to be a species of fungus within the genus *Mucor* in the family of *Mucoraceae* in the order *Mucorales*. The inventive process is based on the discovery that *Mucor miehei* produces a milk-coagulating enzyme (rennin) which is useful in cheese making.

As in *Argoudelis*, supra, the microorganism is an essential starting material in the process, it is *not* of common occurrence, and an experimental screening program trying to find the microorganism in nature again might take a very long time. Hence, the parties agree that reference to a deposit of this microorganism is necessary for a sufficient disclosure under 35 U.S.C. § 112, first paragraph.

The applications of both parties contain such references. Feldman's application refers to several cultures of *Mucor miehei* (by code number) deposited at the Northern Regional Research Laboratory (U. S. Department of Agriculture) in Peoria, Illinois. Aunstrup's application refers to a single culture of *Mucor miehei* (by code number) deposited at Centraalbureau voor Schimmelcultures (which translates as Central Bureau for Mould Cultures) in Baarn, Netherlands (hereafter called CBS). Aunstrup's application also gives a detailed morphological description of the microorganism.

Chronology

The chronology of the pertinent events can be summarized as follows:

Party Aunstrup	Party Feldman
Restricted deposit in CBS Nov. 18, 1965	
British Provisional Specification 51270/65 Dec. 2, 1965	
U.S. Ser. No. 595,643 Nov. 21, 1966	
	U.S. Ser. No. 631,608 April 18, 1967
	U.S. Ser. No. 688,349 Dec. 6, 1967
Deposit made unrestricted March 20, 1969	
Interference declared July 6, 1971	

Facts Surrounding Aunstrup's Deposit

According to Aunstrup's application and his testimony, his specimen of *Mucor miehei* was isolated from a compost pile in his garden in Copenhagen, Denmark, in September 1965. Aunstrup's employer (and assignee) thereafter wrote to CBS with the result that on November 18, 1965 a specimen was deposited with CBS in its collection of "restricted cultures" and given the code number CBS 370.65.

1. Serial No. 595,643, filed November 21, 1966, entitled "Preparation of a Milk-Coagulating Enzyme." The assignee shown in the Declaration of Interference is Novo Terapeutisk Laboratorium A/S of Copenhagen, Denmark.

2. Serial No. 688,349, filed December 6, 1967, entitled "Microbial Rennin," accorded the benefit of Serial No. 631,608, filed April 18, 1967. The assignee shown in the Declaration of Interference is Baxter Laboratories, Inc., of Morton Grove, Illinois.

Dr. Gerardus Albertus De Vries, testifying as an official of CBS, stated that CBS was founded in 1904 by the International Organization of Botanists, that in 1965 CBS was a private foundation which derived financial support from the Dutch government, and that later, in 1968, CBS became part of the Royal Netherlands Academy of Sciences and Arts, which is a governmental organization. Dr. De Vries also testified in detail on the high standards and careful means of preservation employed at CBS to assure permanent viability of the cultures. Dr. Clifford W. Hesseltine,[3] Chief of the Fermentation Laboratory at the Northern Regional Research Laboratory, testified in a private, professional capacity and stated that: "[W]e've had exchanges with C.B.S., and we believe it is a very reliable culture collection."

With respect to a "restricted culture" deposit at CBS, such as CBS 370.65 in 1965, Dr. De Vries stated that such cultures are maintained as a part of the permanent collection, but are made available to third parties only after written consent is given to CBS by the depositor.

Aunstrup further testified that the restrictions on CBS 370.65 were removed on March 20, 1969, by a letter in evidence from Aunstrup's assignee to CBS. Dr. De Vries testified that the official business records of CBS in evidence establish that CBS 370.65 has been unrestricted and "open to the public" since that date. Feldman does not contest this fact.

The Board

Before the board, there were three issues: (1) whether Aunstrup's British Provisional Specification (relied on under 35 U.S.C. § 119) and his corresponding U. S. application (involved herein) satisfied the requirements of 35 U.S.C. § 112, first paragraph; (2) whether Feldman had abandoned the invention; and (3) whether Feldman's priority proofs established an actual reduction to practice. The board decided issue (1) in the affirmative and issues (2) and (3) in the negative.

The Issue

Feldman has appealed only on issue (1). The parties agree that there is no difference in disclosure between Aunstrup's British Provisional Specification and the involved U. S. application. Therefore, the issue narrows to whether Aunstrup's U. S. application satisfies the requirements of § 112, first paragraph. If it does, then Aunstrup is admittedly entitled to the benefit of the filing date of his U. S. application as a "constructive reduction to practice."

Appellant's Contentions

Feldman's first contention is that "there must be assured availability of the [microorganism] deposit to the United States Patent Office as of the filing date" of the U. S. application and to the public "upon issuance of the patent" in order to satisfy § 112, first paragraph, and that this was lacking in Aunstrup's CBS 370.65 deposit.

Feldman's second contention is that "a private depository, recognized and reputable though it may be, which is not an agency of the United States Government, or any government, and which is located in a foreign country, not subject to United States law, can [not] be an acceptable depository for a United States patent."

In support, Feldman argues that "essentially none of the considerations * * * in *Argoudelis* is present," and that the board erred in concluding that the "conditions" of the Commissioner's Notice of April 29, 1971, 886 O.G. 638 (now MPEP 608.01(p)), may be "retroactively satisfied." The Commissioner's Notice provides:

> Deposit of Microorganisms
>
> Some inventions which are the subject of patent applications depend on the use of microorganisms which must

3. This is the same Dr. Hesseltine mentioned in *Argoudelis*.

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be described in the specification in accordance with 35 U.S.C. 112. No problem exists when the microorganisms used are known and readily available to the public. When the invention depends on the use of a microorganism which is not so known and readily available, applicants must take additional steps to comply with the requirements of Section 112.

In re Argoudelis et al. [434 F.2d 1390, 58 CCPA 769], 168 USPQ 99 (CCPA, 1970), accepted a procedure for meeting the requirements of 35 U.S.C. 112. Accordingly, *the Patent Office will accept* the following as complying with the requirements of Section 112 for an adequate disclosure of the microorganism required to carry out the invention:

(1) The applicant, no later than the effective U.S. filing date of the application, has made a deposit of a culture of the microorganism in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted, under conditions which assure (a) that access to the culture will be available during pendency of the patent application to one determined by the Commissioner to be entitled thereto under Rule 14 of the Rules of Practice in Patent Cases and 35 U.S.C. 122, and (b) that all restrictions on the availability to the public of the culture so deposited will irrevocably removed upon the granting of the patent;

(2) Such deposit is referred to in the body of the specification as filed and is identified by deposit number, name and address of the depository, and the taxonomic description to the extent available is included in the specification; and

(3) The applicant or his assigns has provided assurance of permanent availability of the culture to the public through a depository meeting the requirements of (1). Such assurance may be in the form of an averment under oath or by declaration by the applicant to this effect.

A copy of the applicant's contract with the depository may be required by the Examiner to be made of record as evidence of making the culture available under the conditions stated above. [Emphasis ours.]

OPINION

Assured Public Access to the Microorganism Culture

Feldman's first contention relates to the microorganism deposit at CBS as of the 1966 filing date of Aunstrup's U. S. application and the contention is in two parts: (1) "assured availability" *to the PTO* during pendency of Aunstrup's U. S. application, and (2) "assured availability" *to the public* upon issuance of Aunstrup's application as a U. S. patent.

[1] In regard to part (1), we see no merit. Under the authority of 35 U.S.C. § 114,[4] the PTO may require an applicant to furnish specimens for the purpose of inspection or experiment. PTO Rule 93, 37 CFR 1.93,[5] implements this statutory authority. Hence, there is no question that the PTO *could* obtain access to CBS 370.65 *through Aunstrup* at any time during pendency.

In regard to part (2), Feldman relies heavily upon *Argoudelis* and the Commissioner's Notice of April 29, 1971, 886

4. § 114. Models, specimens

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

5. § 1.93 Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

O.G. 638. The basic error in Feldman's position is the elevation of the specific facts presented in *Argoudelis* to the status of a rule of law.

Argoudelis was "a matter of first impression" wherein this court held that the procedure used by appellants was sufficient to justify the conclusion that their specification satisfied the enablement requirement of § 112, first paragraph. This court's opinion by Judge Almond notes four factors (434 F.2d at 1394, 58 CCPA at 775) which were persuasive:

> (1) a public depository was used; (2) the depository is operated by a department of the United States government; (3) the depository is under a contractual obligation to place a culture in the permanent collection, to supply samples to persons legally entitled under Rule 14 and 35 U.S.C. § 122 to access to appellants' application, and to supply samples to anyone seeking them once the patent issues; and (4) there is nothing in the record to suggest that the cultures will undergo any physical changes which will render them unusable.

But this court did not hold, as Feldman contends, that each factory was necessary, or that they were mandatory for a sufficient specification.

[2] The Commissioner's Notice, following and citing *Argoudelis*, states that "the Patent Office will accept the following * * *." It does not say the Patent Office will *only* accept the described procedure. Thus, the Notice does not purport to set forth the minimum requirements, but only a procedure which will assuredly gain PTO acceptance.

[3] It is true, as Feldman asserts, that *as of the 1966 filing date* of Aunstrup's U. S. application, there was no guarantee or assurance of access to CBS 370.65 by the public upon issuance of a U. S. patent on the application. However, the enablement requirement of § 112, first paragraph, does not require such assured access to a microorganism deposit *as of the filing date*; what is required is assurance of access (to the microorganism culture by the public upon issuance of a patent on the application) prior to *or during the pendency* of the application, so that, upon issuance of a U. S. patent on the application, "the public will, in fact, receive something in return for the patent grant." *In re Argoudelis*, 434 F.2d at 1394, 58 CCPA at 776 (Baldwin, J., concurring).

[4] At the time Aunstrup's U. S. application was filed, the invention recited in the count and described in the application was fully capable of being reduced to practice (i. e., no technological problems, the resolution of which would require more than ordinary skill and reasonable time, remained in order to obtain an operative, useful process). Thus, the so-called "second aspect" or second function of § 112, first paragraph—that of establishing the application filing date as the prima facie date of invention—was satisfied by Aunstrup's specification. See *In re Hawkins*, 486 F.2d 569 (CCPA 1973).

[5, 6] The gravamen of Feldman's argument pertains to another function of § 112, first paragraph—that of assuring public access to an essential starting material (the microorganism) in the recited process. This is analogous to the complete public disclosure function of § 112, first paragraph, and that function is only violated if the disclosure is not complete at the time it is made public, i. e., at the issue date. *In re Hawkins*, supra; see *In re Glass*, 492 F.2d 1228, 1234 (CCPA 1974) (Miller, J., concurring). In the present case, this requirement of assured public access to the essential microorganism has been satisfied by Aunstrup's assignee when, on March 20, 1969, during pendency of the involved Aunstrup application, the restrictions on access to CBS 370.65 were removed and the culture was made "open to the public."

Private Foreign Depository

Feldman's second contention is that CBS, as of the 1966 filing date of

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Aunstrup's U. S. application, was a private foreign depository, not an agency of any government, and that these factors render Aunstrup's deposit inadequate per se. Feldman accepts the recognized and reputable status of CBS in 1966, but contends that its private character and its foreign location were fatal defects. The board considered and rejected these arguments.

We concur with Feldman's acceptance of the recognized status of CBS in 1966 (and later). Dr. De Vries' detailed testimony demonstrates the high standards and integrity of CBS. Dr. Hesseltine's expert opinion on the reliability of CBS confirms this point.

[7] But we find no merit in Feldman's argument that Aunstrup's deposit was inadequate per se because CBS was a private institution in 1966. As stated in *Argoudelis*: "The only rational ground for concern on the part of the Patent Office appears to be for the permanent availability of the deposited microorganism." 434 F.2d at 1393–94, 58 CCPA at 775. A culture deposited at CBS would appear to be permanently available insofar as the evidence of record demonstrates the painstaking measures employed by CBS to insure permanent viability of the microorganism. CBS has been part of the Dutch government since 1968 and will presumably continue to be financed and supported by that government. Feldman has introduced no evidence even tending to support a contrary view.

We also find no merit in Feldman's argument that Aunstrup's microorganism deposit was inadequate per se because CBS is located in a foreign country. Feldman has cited no case (other than his erroneous interpretation of *Argoudelis* discussed above) or statute in support of his view, nor has he introduced any evidence providing a factual basis to support his argument.

On the contrary, the only record evidence even remotely related to this point is Dr. De Vries' testimony that CBS 370.-65 is "open to the public," which would include "any person skilled in the art" (§ 112, first paragraph), and Dr. Hesseltine's testimony that "we've had exchanges with C.B.S.," which lends support to Aunstrup's view that there is nothing inadequate per se about this particular foreign depository.

We are aware of proposed legislation on this subject of foreign microorganism deposits (see O. Behr, "The Prescient Microbe Or Where To Deposit A Foreign Body," 57 J.Pat.Off.Soc'y 28 (1975)). Under the present law, and on the present evidentiary record, Feldman has not persuaded us of reversible error in the board's decision.

Accordingly, the decision of the board is affirmed.

Affirmed.

APPENDIX C

In re Interference of Feldman v. Armstrong
Interference No. 97,703

To .....
.....

We acknowledge receipt of the following culture(s), which arrived in good condition:

.....
.....
.....
.....

their C.B.S.-numbers are given in parentheses. We inform you that we shall keep this(these) strain(s):

1) as living culture(s), cultivated on the media we use for these species, and they will be transferred regularly;
2) in lyophilized condition;
3) under mineral oil.

You informed us that this(these) strain(s) is (are) mentioned in your Netherlands Patent application No. ....., filed with the Netherlands Patent Office in The Hague on ..... 19.. As long the above-mentioned application has not been accepted (D. openbaar gemaakt) this(these) strain(s) will only be given to third parties on a formal authorization by you and only to the extent of this authorization. As soon as the Netherlands Patent Office has informed us that the above-mentioned application has been accepted (D. openbaar gemaakt), we shall make this(these) strain(s) in so far as it(they) still occur(s) in the specification available to anyone upon request. As soon as the Netherlands Patent Office has given us notice that the above-mentioned application will not be published, we shall destroy this(these) strain(s).

.....

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Supreme Court, U. S.
FILED
JAN 8 1976
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-824

LOUIS I. FELDMAN, *Petitioner*,

v.

KNUD AUMSTRUP, *Respondent*.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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KNUD AUNSTRUP, *Respondent.*

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Knud Aunstrup, Respondent, respectfully prays that the Petition for Writ of Certiorari of Petitioner Louis I. Feldman be denied by this honorable Court. Respondents grounds and reasons why the cause should not be reviewed by this Honorable Court are as follows:

1. Petitioner has shown no special and important reason why this honorable Court should review the decision of the United States Court of Customs and Patent Appeals.

2. All the questions presented by Petitioner, but one, were not in issue below, have no bearing on the case, and are moot.

3. The one question presented by Petitioner which was in issue below, and which is a properly justiciable issue which this honorable Court may review, lacks any special and important reasons for the exercise of the discretion of this Court.

ARGUMENT

Much of the argument presented by Petitioner is dependent upon a supposed "augumentation" of Respondent's disclosure of the invention in the specification of his application permitted by the decision below, and some "retroactive" benefit of an "augmented disclosure." There is no basis in fact or in the record for such a proposition. Respondent's disclosure stands today exactly as it did upon its filing date and, at such time as United States Letters Patent issue to Respondent, the disclosure in the specification printed in such Letters Patent will still remain unaltered, unchanged and unaugmented. Nothing in the decisions of the Patent and Trademark Office Board of Patent Interferences or of the United States Court of Customs and Patent Appeals could even colorably be construed to permit such an "augmentation," much less give it any "retroactive" effect.

It would appear that Petitioner confuses the specification disclosure with the condition of what is disclosed. Respondent's patent application as filed made a complete disclosure of the microorganism required for practice of the invention, including reference to the deposit previously made. The disclosure thus made in the application specification was complete and suffi-

cient at the filing date and has not been "augmented" in any fashion, and this Court will find nothing in the decision below which would permit Respondent to "augment" the disclosure of his specification. Respondent's disclosure of the invention in his specification is in no manner "augmented" by the removal of restrictions upon access to his deposit during pendency, and he has not been given any "retroactive" benefit of any change in his disclosure since there has been no change of any kind in the disclosure of his specification as originally filed.

It is submitted that clarification of Petitioner's confusion on the foregoing points is fully sufficient and adequate to dispose of questions 2 and 3 presented by Petitioner at page 3 of his petition. A simple clarification of the basis and import of the decision below presents no justiciable issue for determination and does not appear to require or justify the exercise of the discretion of this honorable Court.

For establishing a date of invention, Respondent has relied, as provided by 35 U.S.C. 119, upon the filing date of his prior British application. Respondent has *not* relied upon any other activity in a foreign country to establish a *date of invention,* and has not violated the precepts of 35 U.S.C. 104. Since Respondent's deposit of his microorganism, which occurred in a foreign country, have *not* been relied upon to establish a *date of invention,* it is readily apparent that questions 4 and 5 posed by Petitioner at page 3 of his petition are moot in the present case and pose no justiciable issue for consideration of this honorable Court.

Petitioner asserts no special or important reasons why the remaining question 1 at page 3, of his petition

should be considered by this Court. The current state of the law, as developed in the opinions below, is reasonable and effective and appropriate to the needs of the patent system. Certainly the interest of the legislative branch of the Government in this area does not mandate consideration by this Court. To issue the writ solely on such basis, as Petitioner urges, would be to commit this Court to advise the legislative branch when clearly that function is being performed in appropriate fashion.

CONCLUSION

Respondent submits that the intervention of this honorable Court is not adequately invoked by the instant petition and is not warranted by the nature of the case in controversy nor by any of the questions or arguments posed by Petitioner. It is respectfully prayed that the petition be denied and the writ not issue.

Respectfully submitted,

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January 9, 1976

MF:JSW:kaw